

REMARKS

This application has been carefully reviewed in light of the final rejection of November 19, 2004. It is noted that the previous double patenting rejections based upon claims found in U.S. Patent Nos. 6,646,175, 6,646,176 and 6,713,658 have been withdrawn in view of the previously submitted terminal disclaimers against these patents. With respect to the provisional double patenting rejections based upon claims found in the application serial nos. 09/206,216 and 09/206,218, as noted in applicants' previous response since these are provisional double patenting rejections, there are no double patenting issues at this time. Nevertheless, in an attempt to expedite the prosecution of this application to an early conclusion, applicants submit herewith terminal disclaimers against each of application serial nos. 09/206,216 and 09/206,218.

It is noted that the assignee of record in this application is Fina Research, S.A. as reflected in the assignment dated March 2, 1999 and recorded in the USPTO in March 22, 1999 at Reel 9843, Frame 0252. The assignee of record in each of application serial nos. 09/206,216 and 09/206,218 is likewise Fina Research, S.A. As reflected in the Certificates of Name Change, copies of which are attached hereto, the name of Fina Research, S.A. was changed to ATOFINA Research and the name of ATOFINA Research was then changed to Total Petrochemicals Research Feluy. The terminal disclaimers submitted herewith identify the owner by its current name, Total Petrochemicals Research Feluy. As reflected in MPEP § 314, this change in name of the assignee does not constitute a change in legal entity of the owner.

The prior art rejection of claims 15-22 under 35 U.S.C. § 103 as unpatentable over EPO 109060 in view of Eberly, Jr. et al. is respectfully traversed. To the extent the final rejection repeats the comments found in the Office Actions of June 8, 2004 and October 22, 2003, applicants will refer to the previous arguments made in the responses filed March 23, 2004 and September 13, 2004. In addition to these arguments addressed previously, the Final

Rejection under Response to Arguments presents additional reasons in support of the rejection based upon *In re McLaughlin*, 443 F2d 1392, 170 USPQ 209 (CCPA 1971). The comments made in the Final Rejection based upon the holding of *in re McLaughlin*, 443 F2d 1392, 170 USPQ 209 (CCPA 1971) have been carefully considered. However, the McLaughlin case which led to the conclusion of a *prima facie* case of obviousness, in view of what the reference disclosures would suggest to one of ordinary skill in the art, does not countenance hindsight reconstruction of the prior art of the type condemned in the decisions cited in applicants' previous response filed September 13, 2004. As noted there, the various processes disclosed in EPO '060 and Eberly are so diverse and unrelated that the attempt to combine their teachings is based not on knowledge which was within the level of one of ordinary skill in the art, but on applicants' own disclosure. Further, as noted herein and in applicants' previous response, the combined teachings of the references fall short of applicants' claimed subject matter.

As noted in applicants' previous response, it is incumbent upon the Examiner, when proposing a combination or modification of references, to identify some suggestion to combine the references or make the modification. See *In re Mayne*, 104 F.3d 1339, 1342, 41 USPQ2d 1451, 1454 (Fed. Cir. 1997). Eberly is not directed to MFI-type catalysts and only suggests silica/alumina mole ratios much lower than those required by EP '060 and much lower than those required by applicants' claims. Eberly discloses that higher silica/alumina mole ratios provide greater stability to heat, steam and acid (col. 2, lines 20-25). However, these "higher" silica/alumina mole ratios suggested by Eberly are ratios such as 8:1 to 12:1 (col. 2, lines 25-34), with examples as high as 29:1 (col. 7, lines 73-75, and Table IV). Eberly teaches that heating a catalyst in steam, followed by extraction with EDTA, results in a catalyst with an "extremely high" silica/alumina mole ratio of about 20 (see Table III and col. 7, lines 34-37). The lowest silica/alumina mole ratio suggested by EP '060 is 350 corresponding to an atomic ratio of greater

than 175. The Examiner has not presented any convincing reasoning, suggestion or motivation as to why one of ordinary skill in this art would have modified the process of EP '060 with catalysts already possessing silicon/aluminum atomic ratios of greater than 175, with the catalyst pretreatment of Eberly, when Eberly teaches that silica/alumina mole ratios of 8 through 20 provide sufficiently increased stability. Accordingly, it is respectfully submitted that the Examiner has not presented convincing reasons for the proposed combination of EPO '060 and Eberly and therefore no case of *prima facie* obviousness has been established. Clearly, the standard called for in the Federal Circuit's decision in *In re Jones* 958 F.2d 347, 21 USPQ2d, 1941, (Fed. Cir. 1992) has not been met. There, the court, in reversing the decision below, stated:

"Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." (21 USPQ2d, 1943, 1944)

The appropriate standard for combining the enclosures of the prior art references has not been met.

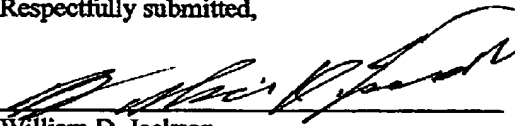
Finally, if one assumes that EP '060 and Eberly can be combined without the sort of hindsight reconstruction condemned by the Board of Appeals and Patent Interferences and the Federal Circuit, the result of combining these prior art teachings still would not lead one of ordinary skill in the art to applicants' invention. Each of applicants' claims requires a propylene yield on an olefin basis of from 30 – 50% based upon the olefinic content of the feedstock. As noted previously in the prosecution of this case, the EP '060 reference does not disclose a propylene yield as claimed, nor is such a propylene yield inherent in the operation of the prior art reference. This appears to be acknowledged in the first full paragraph found on page 4 of the Final Rejection immediately preceding the double patenting rejections. Further, even if the

teachings of the two prior references could be combined, there is no reason to assume a propylene yield of 30 – 50 wt.% as called for in applicants' independent claims 15 and 21. Moreover, the prior art references, no matter how combined, would not lead one of ordinary skill in the art to an operation involving the propylene content of 95 wt.% of C₃ compounds as set forth in claim 16, the inlet temperature set forth in claim 17 and the space velocity as set forth in claim 18. With respect to Example 24 of EP '060, it is noted that this example refers to the use of silicalite-1, having a silica/alumina ratio of infinity, that is, a silicon/aluminum atomic ratio in excess of the claimed range of 180-1,000. Further, the space velocity in Example 24 is specifically disclosed to be substantially below the range recited in claim 18.

In view of the foregoing reasons and the arguments presented previously in the prosecution of this application, it is respectfully submitted that claims 15-22 are clearly patentable over the combination of EP '060 and Eberly. Accordingly, an early reconsideration and allowance of this application is respectfully requested.

The Commissioner is hereby authorized to charge the fee of \$260 for the filing of the two terminal disclaimers attached herewith for a large entity, the fee of \$450 for a two-month extension for response for a large entity (thus extending the response deadline to April 19, 2005), and any additional fee that may be due in connection with the filing of these papers to the Locke Liddell & Sapp LLP Deposit Account No. 12-1781.

Respectfully submitted,



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